



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chern : Attorney Docket No.: 01-40257-US
Serial No.: 09/881,671 :
Filed: June 18, 2001 : Group Art Unit: 2153
For: VOICE ATTACHMENT TO AM EMAIL USING A WIRELESS COMMUNICATION DEVICE : Examiner: Nash, Lashanya R.

PETITION UNDER 37 C.F.R. § 1.181 and 37 C.F.R. § 1.137(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The applicant in the above-identified patent application (the "Petitioner") respectfully petitions the Director under 37 C.F.R. § 1.181 and 1.137(b) to withdraw the abandonment of above-identified application and accept the Request for Continued Examination, thereby reinstating the present application, without prejudice, inasmuch as the application was unintentionally abandoned. Enclosed is a first credit card payment for the fee pursuant to 37 C.F.R. § 1.114 for a Request for Continued Examination in the amount of \$790.00, and second credit card payment for the surcharge pursuant to 37 C.F.R. § 1.17(m) in the amount of \$1,500.00, paid as a condition of accepting an unintentionally delayed filing of a Request for Continued Examination. The Director is hereby authorized to charge any deficiencies or credit any overpayments to Deposit Account No. 18-0586.

EXPRESS MAIL CERTIFICATE (37 CFR 1.10)

Express Mail Label No. EV342398578US

Date of Deposit November 8, 2006

I hereby certify that this paper, and the papers and/or fees referred to herein as transmitted, submitted or enclosed, are being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated above and is addressed to the Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name Deborah A Springfield

Signature Deborah A Springfield

DISCUSSION

Petitioner contends that the entire delay in filing the Request for Continued Examination ("RCE") from the due date for the RCE until the filing of this petition was unintentional. Thus, Petitioner respectfully requests the Director, pursuant to 37 C.F.R. §§ 1.181 and 1.137(b), accept a delayed filing of a RCE for the present Application, without prejudice, thereby reinstating the present Application.

I. Petition to the Director under 37 C.F.R. §§ 1.137(b) and 1.181 is Authorized

Petitioner respectfully submits that a petition to the Director is authorized under 37 C.F.R. § 1.181 due to Petitioner's contentions under 37 C.F.R. § 1.137(b). Under 37 C.F.R. § 1.137(b), petitions are authorized as it states:

...a petition may be filed...to revive an abandoned application...[which] must be accompanied by... (3) [a] statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition...was unintentional. The Director may require additional information where there is a question whether the delay was unintentional." *37 C.F.R. § 1.137(b)*.

Under 37 C.F.R. § 1.181, a "[p]etition may be taken to the Director:...(2) [i]n cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and (3) [t]o invoke the supervisory authority of the Director in appropriate circumstances." In the present case, this petition is being made under 37 C.F.R. § 1.137(b), which authorizes this petition because the supervisory authority of the Director is being invoked. Additionally, 37 C.F.R. § 1.181 further authorizes this petition because making a determination on a petition is a supervisory authority of the Director, under 37 C.F.R. § 1.181. Thus, this petition to the Director is authorized.

II. The RCE Filed Herewith Should be Accepted under 37 C.F.R. § 1.137(b)

Petitioner respectfully requests the Director revive the present application and accept a delayed filing of a RCE under 37 C.F.R. § 1.137(b), without prejudice, as the entire delay in filing a RCE under 37 C.F.R. § 1.114, from the day that a reply was due until to the filing of this petition, was unintentional. In order to petition for reinstatement, a petitioner must include:

- (1) [t]he reply required to the outstanding Office action or notice...; (2) [t]he petition fee set forth in § 1.17(m); (3) [a] statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional ...; and (4) [a]ny terminal disclaimer...required pursuant to paragraph (d)... 37 C.F.R. § 1.137(b).

Petitioner submits that all parts of 37 C.F.R. § 1.137(b) have been satisfied with the payments enclosed, the RCE filed herewith which meets the requirements of 37 C.F.R. § 1.114, and the enclosed copy of the Response to Final Official Action, previously submitted on February 21, 2006, as a submission to accompany the RCE. In addition, a terminal disclaimer is not required in the Application at the present time. Petitioner also submits that this petition is being filed promptly and diligently. Thus, Petitioner respectfully submits that this petition should be accepted because the entire delay in filing a RCE was unintentional.

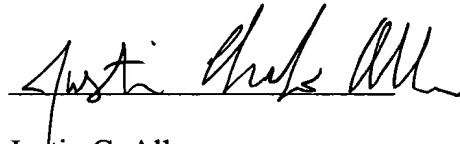
CONCLUSION

Accordingly, for the reasons set forth above, Applicant respectfully petitions the Director, without prejudice, to withdraw the Notice of Abandonment issued against the Application under 37 C.F.R. §§ 1.181 and 1.137(b) for unintentional abandonment, and accept the RCE filed herewith.

Respectfully Submitted,

REED SMITH LLP

Dated: November 8, 2006

A handwritten signature in black ink, appearing to read "Justin C. Allen", is written over a horizontal line.

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February 21, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chern
Serial No.: 09/881,671
Filed: June 18, 2001
Attorney Docket No.: 01-40257-US
For: "Voice Attachment To An E-Mail Using A Wireless Communication Device"

TRANSMITTAL

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed for filing is a response to the Office Action which has a mailing date of December 13, 2005 in the above-entitled invention. The following documents are submitted herewith:

- 1) Response to Office Action dated December 13, 2005;
- 2) A self-addressed stamped return receipt postcard

EXPRESS MAIL CERTIFICATE (37 CFR 1.10)

Express Mail Label No. EV 481 405 707 US

Date of Deposit February 21, 2006

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Name

Dolores T. Springfield

Signature

Dolores T. Springfield

EV481405707US

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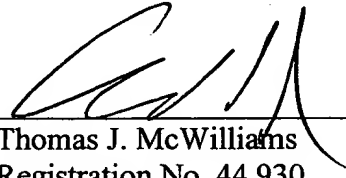
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Commissioner for Patents
February 21, 2006
Page 2

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The Commissioner is hereby authorized to charge any additional fees required or credit any overpayment in connection with this filing to Deposit Account No. 18-0586

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: **Chern** : Examiner: **Nash, LaShanya**
: :
U.S. Application No: **09/881,671** : Group Art Unit: **2153**
: :
Filing Date: **June 18, 2001** : Attorney Docket No.: **01-40257-US**
: :
For: **Voice Attachment to an Email Using a Wireless Communication Device**

RESPONSE TO FINAL OFFICIAL ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated December 13, 2005, Applicant respectfully requests reconsideration of the above-identified application for the reasons set forth herein, which was assigned a shortened statutory period for response, set to expire March 13, 2006. Accordingly, the present response is deemed to be timely filed.

Should there be any additional fees due and owing with respect to this amendment and response, the Examiner is authorized to charge such fees to Deposit Account No. 18-0586.

EXPRESS MAIL CERTIFICATE (37 CFR 1.10)

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Date of Deposit February 21, 2006

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Name

Dolores A. Springfield

Signature

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STATUS OF THE CLAIMS

Claims 1-18 are pending in the Application.

Claims 1-18 stand rejected.

Claims 19-26 were cancelled.

CLAIM LISTING

Applicant respectfully submits the following claim listing and amendments to replace and supersede all previous claim listings:

Claim 1. (original) A method for sending an audio file to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device, comprising:

communicatively connecting to a first server over the wireless communications network;

selecting an option to send the audio file to the email recipient;

communicatively connecting to a second server over the wireless communications network;

recording the audio file on the second server; and

sending the audio file to the email recipient.

Claim 2. (previously presented) The method of claim 1, wherein the communicatively connecting to a first server further comprises:

dialing a phone number for connecting to the first server using the wireless communication device; and

establishing a data packet connection between the wireless communication device and the first server.

Claim 3. (previously presented) The method of claim 1, wherein the selecting an option to send the audio file further comprises:

selecting an option for composing a new email file; and

selecting an option for attaching the audio file to the new email file.

Claim 4. (previously presented) The method of claim 1, wherein the selecting an option to send the audio file further comprises;

viewing a received email file on the wireless communication device;

selecting an option to respond to the received email file; and

selecting an option for attaching the audio file to the response to the received email file.

Claim 5. (previously presented) The method of claim 1, wherein the communicatively connecting to a second server further comprises:

transmitting a signal to the second server indicating a pending connection with the wireless communication device;

terminating the connection with the first server; and

establishing an audio connection between the wireless communication device and the second server.

Claim 6. (previously presented) The method of claim 5, wherein the transmitting a signal to the second server further comprises sending user identification information to the second server.

Claim 7. (previously presented) The method of claim 5, wherein the terminating the connection with the first server comprises storing a set of state information on the wireless communication device, the state information comprising a status of an interaction between the wireless communication device and the first server for allowing the wireless communication device to return to the same state in the first server that existed prior to terminating the connection.

Claim 8. (previously presented) The method of claim 1, wherein the recording the audio file comprises:

providing an audio input through the wireless communication device; and

storing the audio input as an audio file on the second server.

Claim 9. (previously presented) The method of claim 8, further comprising providing the user with at least one option, the option selected from the group consisting of:

re-recording the audio file, canceling the recording, and sending the audio file to the email recipient.

Claim 10. (previously presented) The method of claim 1, wherein the sending the audio file to the email recipient further comprises:

transmitting a signal to the first server indicating that the audio file is ready to be sent;

attaching the audio file to an electronic mail file; and

sending the electronic mail file to the email recipient.

Claim 11. (previously presented) The method of claim 1, further comprising:

disconnecting from the first server in order to communicatively connect to the second server; and

reconnecting to the first server.

Claim 12. (previously presented) The method of claim 11, wherein the reconnecting to the first server comprises providing the user with a plurality of options selected from the group consisting of:

listening to a second audio file stored on the second server, and reconnecting to the first server.

Claim 13. (original) The method of claim 1, wherein the first server comprises an email server.

Claim 14. (original) The method of claim 1, wherein the second server comprises an interactive voice response server.

Claim 15. (original) The method of claim 1, wherein the first and second servers are connected by common platform means.

Claim 16. (original) The method of claim 1, wherein the audio file comprises a .wav file.

Claim 17. (previously presented) The method of claim 1, wherein the sending the audio file to the email recipient comprises sending a hyperlink to the audio file stored on the second server.

Claim 18. (original) A method for sending a message to an electronic mail (email) recipient over a wireless communications network from a user of a wireless communication device, comprising:

dialing a phone number for communicatively connecting to an email server in a data packet connection over the wireless communication network;

selecting an option to send a voice message to the email recipient;

recording the voice message on an interactive voice response server; and

sending the voice message in an attachment to an email to the email recipient.

Claims 19 - 26. (cancelled)

REMARKS

Applicant respectfully requests reconsideration of the subject application for the reasons set forth herein.

35 U.S.C. § 103(a) Rejections

Claims 1-2, 4-6, 8-10, 13-14, and 16-18 stand rejected as being unpatentable over Qua, U.S. Patent No. 6,222,909 ("Qua"), in view of Gupte et al, U.S. Patent Application Publication No. 2001/0034225 ("Gupte"). Claim 3 stands rejected as being unpatentable over Qua and Gupte, as applied to Claims 1-2, 4-6, 8-10, 13-14, and 16-18, and further in view of Oakes et al, U.S. Patent No. 6,205,342 ("Oakes"). Claims 7, 11, 12 stand rejected as being unpatentable over Qua and Gupte, as applied to Claims 1-2, 4-6, 8-10, 13-14, and 16-18, and further in view of Gibson et al, U.S. Patent Application Publication No. 2002/0016174 ("Gibson"). Claim 15 stands rejected as being unpatentable over Qua and Gupte, as applied to Claims 1-2, 4-6, 8-10, 13-14, and 16-18, and further in view of Segur, U.S. Patent No. 6,212,550 ("Segur"). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Hence, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Qua and Gupte Do Not Teach the Sequence of Steps of the Present Invention

Independent Claim 1 discloses a “method for sending an audio file to an electronic mail (email) recipient over a wireless communications network...comprising: communicatively connecting to a first server...; selecting an option to send the audio file...; communicatively connecting to a second server...; recording the audio file...; and sending the audio file...” Like wise, independent Claim 18 discloses a “method for sending a message to an electronic mail (email) recipient...from a user of a wireless communication device, comprising: dialing a phone number for...connecting to an email server...; selecting an option to send a voice message to the email recipient; recording the voice message...; and sending the voice message...” Neither Qua nor Gupte teaches the sequence of steps disclosed in Applicant's method.

Applicant respectfully submits that the Examiner has agreed that Qua “does not expressly disclose the aforementioned steps as sequentially consistent with the claimed invention...” *Office Action of December 13, 2005*, page 5. Thus, Qua does not teach each and every element of Claim 1. Thus, Qua fails to teach the method of sending an audio file as disclosed in Applicant's invention.

Further, Applicant respectfully submits that Gupte, likewise, fails to disclose the sequence of steps disclosed in Claim 1. The present Office Action asserts that Gupte teaches only the first step in the sequence of steps in Claim 1 which discloses “communicatively connecting to a first server...” at paragraph [0014], lines 1-16 and paragraph [0016], lines 1-6. *Office Action of December 13, 2005*, page 6. The present Office Action makes no mention of Gupte teaching any other step of Applicant’s Claim 1 or Claim 18, such as, for example, subsequently recording a voice message on a voice response server. Applicant respectfully submits that Gupte fails to teach the sequence of steps in Claim 1 and Claim 18 and, thus, Gupte fails to teach the method of sending an audio file disclosed in Applicant’s invention.

Furthermore, Applicant respectfully submits that it is not obvious to modify the sequence of steps disclosed in Qua with disclosures in Gupte to arrive at Applicant’s invention, as asserted in the present Office Action. Qua discloses a sequence wherein a user first records and stores the audio note on a processor and, thereafter, a user may forward the recording via an email system. *See Qua*, Figure 1. The system in Qua teaches connecting to an email system via a wireless network *after* recording and storing the audio note. *Id.* If the elements taught in Qua were modified with the disclosures in Gupte regarding *first* connecting to an email system (*see Gupte*, paragraph [0014] and [0016]), an impossibility would exist because the system in Qua does not disclose, subsequently, recording and storing an audio note and making a connection to a second server after *already being connected* to the email system. *See, generally, Qua.* Because the system in Qua would be wholly inoperable, even considering the modification with Gupte, when the steps in Qua are rearranged to match the steps in Applicant’s invention, Applicant respectfully asserts that Applicant’s invention is not obvious.

Lastly, Applicant also respectfully asserts that no motivation exists to modify the sequence of steps disclosed in Qua with disclosures in Gupte to arrive at Applicant's invention. The present Office Action asserts that "one...would have been so motivated to implement [the modification of Qua] so as to provide easy access to *selected emails or other electronic communications* via a wireless device." *Office Action of December 13, 2005*, page 6, citing *Gupte*, paragraph [0006], lines 6-10, emphasis added. Applicant respectfully asserts that this disclosure in Gupte does not describe easy access to *voice attachments or audio files*, which is the spirit of Applicant's invention. Because Gupte fails to disclose the easy access to *voice attachments or audio files*, Applicant respectfully submits that no motivation exists in Gupte to so modify the sequence of steps in Qua to match the sequence of steps disclosed in Applicant's invention. Thus, Applicant respectfully submits that Applicant's invention is not obvious.

Therefore, Applicant submits that the cited references of Qua and Gupte, neither individually nor in combination, teach or suggest the sequence of steps as taught in independent Claims 1 and 18 of Applicant's invention.

Accordingly, Applicant submits at least the independent Claims 1 and 18 of Applicant's invention are patently distinguishable over the prior art of record. Applicant further submits that each of the dependent claims (Claims 2-17) are similarly distinguishable over the prior art of record, at least by virtue of each Claim's ultimate dependency from the patently distinct base Claim 1.

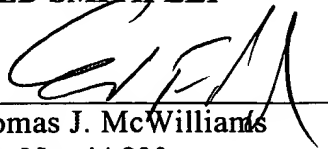
Conclusion

Wherefore, Applicant respectfully believes all outstanding grounds raised by the Examiner have been addressed, and thus respectfully submits the present case is in condition for allowance, early notification of which is earnestly solicited.

Date: February 21, 2006

Respectfully Submitted,

REED SMITH LLP



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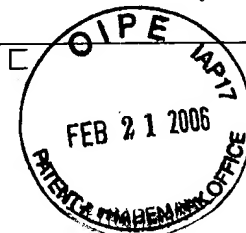
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Serial No.	09/881,671	Applicant	Chern	Filing Date	June 18, 2001	Examiner:	LaShanya Nash			
Title:	Voice attachment to an e-mail using a wireless communication device					Docket No:	01-40257-US			
Delivery Method										
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Serial No.	09/881,671	Applicant	Chern	Filing Date	June 18, 2001	Examiner:	LaShanya Nash			
Title:	Voice attachment to an e-mail using a wireless communication device					Docket No:	01-40257-US			
Delivery Method										
Deposit Date	<input type="checkbox"/> 1 st Class Mail (37 CFR 1.8)		<input checked="" type="checkbox"/> Express Mail (37 CFR 1.10)		Express Mail No: EV 481 405 707 US					
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<input type="checkbox"/> Utility	Specification		<input type="checkbox"/> Declaration							
<input type="checkbox"/> Divisional	Claim		<input type="checkbox"/> Power of Attorney							
<input type="checkbox"/> CPA Request	Drawings		<input type="checkbox"/> Response to missing parts							
<input type="checkbox"/> Continuation	Abstract		<input type="checkbox"/> Notice of missing parts							
<input type="checkbox"/> CIP	Sequence Listing		<input type="checkbox"/> Assignment and Recordation Cover Sheet							
<input type="checkbox"/> RCE Request	Application Cover		<input checked="" type="checkbox"/> Return receipt postcard							
<input type="checkbox"/> Design			<input type="checkbox"/>							
Miscellaneous			Amendment/Response							
<input checked="" type="checkbox"/> Transmittal Letter		<input type="checkbox"/> Preliminary	<input type="checkbox"/>							
<input type="checkbox"/> Fee Calculation and Utility Transmittal Sheet		<input checked="" type="checkbox"/> After Office Action								
<input type="checkbox"/> Petition for Extension of time		<input type="checkbox"/> After Final Office Action								
<input type="checkbox"/> IDS, PTO-1449 Form, and copies of IDS references: references		<input type="checkbox"/> After Notice of Allowance								
		<input type="checkbox"/> Supplemental								
<input type="checkbox"/> Request for Corrected Filing Receipt		<input type="checkbox"/>	<input type="checkbox"/>							
<input type="checkbox"/> Drawings: sheets										
<input type="checkbox"/> Issue Fee Transmittal		<input type="checkbox"/> Notice of Appeal								
<input type="checkbox"/> Status Request		<input type="checkbox"/> Appeal Brief								
<input type="checkbox"/> Change of Correspondence Address		<input type="checkbox"/> Reply Brief								
<input type="checkbox"/> Request for Certificate of Correction		<input type="checkbox"/> Withdrawal of Appeal	Client/Matter No. 953267.20079							
						Reference Atty: E. Behm, Jr.				



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